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JUL 14 2004

OFFICE OF PETITIONS

In re Application of :
Thompson :
Application No. 09/396,128 :
Filed: September 14, 1999 :
Attorney Docket No. N/A :
For: HURRICANE-EARTHQUAKE FRIEZE :
PLATE :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed May 10, 2004 (certificate of mailing date May 5, 2004), to revive the above-identified application.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A non-final Office action was mailed on June 26, 2002, which set an extendable 3 month period for reply. Petitioner filed an amendment with a one month extension of time on November 4, 2002 (certificate of mailing date October 26, 2002). The above-identified application became abandoned for failure to timely submit a reply to the letter of Informality Re Payment of Fee, mailed November 21, 2002, which required applicant to submit \$114 in excess claim fees owed within the original period set in the June 26, 2002 non-final Office action or within one month of the mail date of the November 21, 2002 letter, whichever was longer. A reply was received on February 5, 2003, but the reply was untimely. This application became abandoned on December 22, 2002. A Notice of Abandonment was mailed on March 12, 2003. Applicant's first petition to withdraw the holding of abandonment, filed August 14, 2003 and supplemented on October 19, 2003, was dismissed on April 27, 2004. Applicant's second petition to withdraw the holding of abandonment, filed May 5, 2004, was dismissed on June 2, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

Regarding (1) above, petitioner has not properly responded to the November 21, 2002 letter of Informality Re Payment of Fee. Petitioner argues that the \$114 fee required for the eight claims in excess of the twenty previously paid for and for the fourth independent claim is mistaken. Petitioner argues that the USPTO clerk miscounted the number of claims submitted in the November 4, 2002 (certificate of mailing date October 26, 2002) amendment. Petitioner asserts that only claims 20-39, twenty claims, including two independent claims, are pending.

Petitioner is informed that Examiner Tran did not cancel claims 1-19 in the June 26, 2002 non-final Office action. The June 26, 2002 non-final Office action clearly states that Claims 12-31 are pending and the Detailed Action points out that it appeared applicant's intent was to cancel claims 1-19 and then add new claims, but the March 4, 2002 CPA requested that the Office cancel only claims 1-11 and add claims 12-31. For the purposes of examination, Examiner Tran renumbered the new claims as 20-39. Examiner Tran requested clarification of petitioner's intent.

Rule 126 states that when claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented. Examiner Tran followed this rule, but he did not cancel any claims beyond the requested claims, numbers 1-11. Petitioner never requested that Examiner Tran cancel claims 12-19. Petitioner did not include a parenthetical expression following the claim number indicating the status of the claim in the November 4, 2002 (certificate of mailing date October 26, 2002) amendment. Petitioner did include a marked up version of claims 12-19. 37 CFR 1.121(c)(1)(ii) states that a marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or cancelled. In short, petitioner did not follow claim amendment rules.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required. The additional fees due with an amendment are calculated on the basis of the claims which would be present if the amendment were entered. The November 4, 2002 (certificate of mailing date October 26, 2002) amendment left 4 independent claims and eight claims in excess of the twenty previously paid for.

The \$114 fee was and is properly required.

Regarding (3) above, petitioner has not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). Petitioner failed to follow USPTO rules. The delay was not unavoidable.

Regarding petitioner's travel to the Philippines and his vacation effecting his ability to respond to the November 21, 2002 letter, petitioners' preoccupation with other matters which took precedence over the above-identified application does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

The petition under 37 CFR 1.137(a) is **dismissed**.

ALTERNATE VENUE

Petitioner is encouraged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the required \$665.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). For petitioner’s convenience, a blank PTO/SB/64 -- Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

A handwritten signature in cursive script, appearing to read "E. Shirene Willis".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

enclosures: blank PTO/SB/64 -- Petition for Revival of an Application Abandoned
Unintentionally under 37 CFR 1.137(b)

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